

REMARKS

Claims 1, 4-8, and 10-19 are pending in the application. Claims 1, 4, 5, 7, 8 and 10 are amended in this response; claims 11-19 are new. In the Official Action mailed January 24, 2008, the Examiner rejected claims 1, 4 and 5 as being anticipated by Sun et al., US 2004/0019063 per 35 U.S.C. §102(e), and rejected claims 1, 4, 5 and 10 as being obvious in view of Sun et al. The Examiner also stated that claims 6-8 were not allowable because they depended from a rejected base claim but would be allowable if rewritten in independent form.

Before explaining the present amendments and responding to the anticipation rejection, Applicants note that at the time the presently claimed invention was invented, the Applicants were under a duty to assign to the same assignee of record in the '063 publication, viz. Bristol-Myers Squibb Company. Consequently, under 35 U.S.C. §103(c), **the '063 publication cannot be cited against the present application as the basis for a §103 obviousness rejection.**

Claim 1

Claim 1 has been amended to delete the recitation that formula I includes stereoisomers, inasmuch as, to the extent that the stereochemistry of the molecule is not depicted in formula I, formula I by definition encompasses all stereoisomers. See e.g. paragraph 101 of the published specification. Additional amendments have also been made in claim 1 for the sake of clarity, e.g. the definition of G has been amended to more clearly recite that G is selected from the group consisting of the four structures shown, and the definition of substituents A-F has been amended to more clearly recite that each of A-F is independently selected from N and CR₁. Provisos (b) and (c) have been amended to more clearly recite what is excluded from the claim. Also, in the structure for G shown in proviso (c), the substituents on the naphthalene moiety have been renamed AA and BB, so as to avoid confusion with the substituents A and B recited earlier in the claim. Finally, in claim 1, the definition of R₁ has been amended to exclude H. It is respectfully submitted that none of these amendments introduce new matter.

In the Official Action, the Examiner asserted that formula Ih in the '063 publication shows a genus of compounds that include some of the presently claimed compounds. Applicants respectfully submit that the Examiner is mistaken in this conclusion, since proviso (b) of claim 1, both as originally filed and in its present form, excludes from claim 1 the prolyl methyl esters of formula Ih of the '063 publication, as well as compounds of formula IVa of the '063 publication.

Furthermore, it is respectfully submitted that in view of the deletion of H from the definition of R₁ in claim 1 (as now amended), compounds such as compounds of formula XIX or the compound shown in Example 54B of the '063 publication are no longer within the scope of present claim 1. It is thus submitted that there are no compounds disclosed in the '063 publication that fall within the scope of claim 1, and therefore claim 1 is novel over the '063 publication.

Since, as noted above, the '063 publication is not available as prior art for purposes of an obviousness rejection against the present application, Applicants believe there is no longer a basis for rejection of claim 1, and allowance of this claim is respectfully requested.

Claim 4

Claim 4 depends from claim 1. In accordance with the amendments in claim 1, the definition of R₁ in claim 4 has been amended so that H is no longer recited. This claim has also been amended to clarify that pharmaceutically acceptable salts are within the scope of the claim.

Claim 5

Claim 5 has been amended to clarify that the pharmaceutical composition includes a compound according to claim 1 or a pharmaceutically acceptable salt thereof, not "the" compound of claim 1. A typographical error in the word "therefor" has also been corrected.

Claims 7, 8 and 10

Claims 7, 8 and 10 have been amended to clarify that they include pharmaceutically acceptable salts of the recited compounds.

New claims 11-14

New claims 11-14 correspond to claims 5-8, but refer to the compounds or salts recited in claim 10 rather than the compounds or salts recited in claim 1.

New claims 15-19

New claim 15 corresponds to claim 1 as filed in on August 29, 2007, but the definition of R₃ has been limited to alkyl, substituted alkyl and CH₂OR₄. It is respectfully submitted that this

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limitation, in combination with proviso (b), excludes from claim 15 compounds of formulae Ih, IVa, XIX or Example 54B of the '063 publication, and therefore this claim is novel over that publication. Since, as explained above, the '063 publication cannot be used against the present application as a §103 reference, it is respectfully submitted that new claim 15 is allowable. New claims 16-19 correspond to claims 6-9 but refer to the compounds or salts recited in claim 15 rather than the compounds or salts recited in claim 1.

In view of the foregoing amendments and remarks, it is submitted that the application is in condition for allowance. Allowance thereof is respectfully requested.

Sincerely yours,



Daniel J. Feigelson
Applicants' representative